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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ken Alan Berkun

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EXAMINER

BENGZON, GREG C

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/876,943	Applicant(s) BERKUN ET AL.	
	Examiner GREG BENZON	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :07/01/2008,09/19/2008,05/11/2009.

DETAILED ACTION

This application has been examined. Claims 1-17 are pending.

This Office Action is issued in response to BPAI Decision - Examiner Affirmed in Part filed 03/31/2009 including new grounds of rejection set forth by the BPAI and furthermore Applicant Amendments filed on 05/11/2009 per 37 CFR 41.50.

Making Final

Applicant's arguments filed 05/11/2009 have been fully considered but they are not persuasive.

The claim amendments regarding -- '*wherein the authoritative source is a source other than a person*' -- and -- '*data transmission network conveying computer-executable instructions*' -- do not overcome the disclosure by the prior art as shown below.

The Examiner presents new grounds for rejection as necessitated by claim amendments and is thus making this action FINAL.

Priority

This application claims benefit of priority from provisional application 60/252273 (November 21, 2000) .

The effective date of the subject matter described in the pending claims in this application is November 21,2000.

Response to Arguments

Applicant's arguments filed 05/11/2009 have been fully considered but they are moot in view of the new grounds for rejection.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claim 10 recites '*a program readable medium*'.

The Applicant Specification does not provide sufficient guidance on what comprises a program readable medium.

Claims 11-17 recite '*a data transmission network conveying computer-executable instructions.*'

While the Applicant Specifications describe a transmission medium the Examiner notes that the Applicant Specification does not provide sufficient guidance on what comprises a data transmission network and furthermore does not clearly indicate computer instructions that are conveyed/transmitted/relayed by a network.

The claim or claims must conform to the invention as set forth in the remainder of the specification and the *terms and phrases used in the claims must find clear support or antecedent basis in the description* so that the meaning of the terms in the claims may be ascertainable by reference to the description.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11-17 pertain to '*a data transmission network conveying computer-executable instructions.*' Upon inspection of the Applicant Specifications (Page 8, Page 29) the Examiner interprets the data transmission network as comprising entirely of

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transmission mediums such as wires and carrier waves. The Examiner notes that transmission mediums embodying computer-executable instructions are non-statutory subject matter.

The Examiner notes that where carrier waves are concerned, the transmission medium is an embodiment of a data signal. Absent some physical context, a signal per se is an abstract idea in much the same way that a mathematical algorithm without context is an abstract idea.

Where transmission medium is embodied by wires and cables, the transmission medium is an embodiment of an object which would not be structurally and functionally interconnected to the software in such a manner as to enable the software to act as a computer component and realize any functionality. In this case the transmission medium is likened to a piece of paper with computer-instructions written on it.

The Examiner notes that regardless of the transmission medium a computer does not act according to the computer instructions conveyed by said medium until 1) the said instructions are embedded or stored in the computer's persistent storage memory and 2) are assigned a storage address that is locatable by a computer processor and 3) are invoked for execution by the computer processor.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-3,5-11, 13-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Srivastava et al. (US Patent 654922) in view of Hoffert (US Patent 6374260).

With respect to Claim 1, Srivastava discloses a method for enhancing metadata associated with media on a communications network, said method comprising the steps of: parsing said metadata associated with said media into at least one field of metadata; (Column 1 Lines 40-65, Column 2 Lines 40-65) comparing each of said at least one field of metadata with at least one field of metadata from an authoritative source, each field of metadata compared with each field of authoritative metadata being a compared field; (Column 5 Lines 1-5) and modifying said metadata if said compared field does not match at least one field of authoritative metadata (Column 6 Lines 15-20) wherein code implementing the method is stored in memory of the computing system for execution by

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a processor of the computing system. (Srivastava-Column 4 Lines 40-45, 'extraction module')

While Srivastava (re. Claim 1) substantially disclosed the claimed invention Srivastava did not disclose wherein the authoritative source is a source other than a person. Srivastava disclosed only querying external sources on the Internet for media annotations but did not explicitly disclose wherein the authoritative source is a source other than a person.

Hoffert disclosed a metadata database (Hoffert-Column 8 Lines 55-60) with a software agent (Hoffert-Column 8 Lines 60-65) for continually updating/modifying the media content metadata (Hoffert-Column 9 Lines 15-25). The Hoffert metadata database is equivalent to an authoritative source because it provides the source media file, is able to detect changes in the attributes of the media file including relevant text descriptions external to the media file itself, and the software agent uses the metadata database to propagate the changes to other copies of the media file. Thus Srivastava would have been motivated to use Hoffert's metadata database as an external source for updated media annotations that are not directly extracted from the media file itself.

Srivastava and Hoffert are analogous art because they present concepts and practices regarding extraction, update and management of metadata associated with

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media files. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate a metadata database for checking the validity of metadata related to a media file as taught by Hoffert into the method and system described by Srivastava. The motivation for said combination would have been to provide preview information on multimedia files to help users select a desired media file. (Hoffert-Column 3 Lines 5-10)

With respect to Claim 2, Srivastava-Hoffert discloses a method in accordance with claim 1, wherein said step of modifying said metadata comprise at least one of replacing said compared field with a corresponding field of said authoritative metadata, correcting said compared field in accordance with a corresponding field of said authoritative metadata, and adding at least one field of authoritative metadata to said metadata. (Srivastava-Column1 Lines 40-65,Column 2 Lines 40-65)

With respect to Claim 3, Srivastava-Hoffert discloses a method in accordance with claim 1, wherein said authoritative metadata is obtained from at least one of a multimedia file, a streaming media file, a uniform resource indicator (URI), a database, a media file header, a media file footer, a metatag, and a transport stream (Srivastava-Column 3 Lines 1-10 Column 4 Lines 30-60)

With respect to Claim 5, Srivastava-Hoffert discloses a method in accordance with claim 1, wherein said media comprises at least one of an extension selected from the group consisting of ram, .rm, rpm, .mov, .qif.wma, .cmr, .avi, .swf, .swl .mpg, .mpa,

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.mp1, .mp2, .mp3, m3a, and .m3u. (Srivastava-Column 1 Lines 20-50 Column 4 Lines 30-60)

With respect to Claim 6, Srivastava-Hoffert discloses a method in accordance with claim 1, wherein said metadata comprise elements related to at least one of content of the media, intellectual property rights associated with the media, and instantiation of the media.(Srivastava-Column 2 Lines 20-40)

With respect to Claim 7, Srivastava-Hoffert discloses a method in accordance with claim 1, wherein said media comprises at least one of multimedia and streaming media. (Srivastava-Column 2 Lines 20-40 Column 4 Lines 30-60)

With respect to Claim 8, Srivastava-Hoffert discloses a method in accordance with claim 1, wherein said communications network is a computer network.(Srivastava-Figure 1)

With respect to Claim 9, the applicant discloses a system with the same limitations described in Claim 1. Claim 9 is therefore rejected on the same basis as Claim 1.

With respect to Claim 10, the applicant discloses a program readable medium with the same limitations described in Claim 1. Claim 10 is therefore rejected on the same basis as Claim 1.

With respect to Claim 11, the applicant discloses a data transmission network conveying computer-executable instructions with the same limitations described in Claim 1. Claim 11 is therefore rejected on the same basis as Claim 1.

With respect to Claim 13, Srivastava-Hoffert discloses wherein said media comprises at least one of an extension selected from the group consisting of .ram, .rm, .rpm, .mov, .qif, .wma, .cmr, .avi, .swf, .swl, .mpg, .mpa, .mp1, .mp2, .mp3, m3a, and .m3u (Srivastava-Column 1 Lines 20-50 Column 4 Lines 30-60)

With respect to Claim 14, Srivastava-Hoffert discloses wherein said modify metadata code segment performs at least one of replacing said compared field with a corresponding field of said authoritative metadata, (Srivastava -Column 5 Lines 1-5, '*advanced querying*') correcting said compared field in accordance with a corresponding field of said authoritative metadata, and adding at least one field of authoritative metadata to said metadata. (Srivastava-Column 1 Lines 40-65, Column 2 Lines 40-65, Column 6 Lines 15-20, '*overriding annotations with completely new set*')

With respect to Claim 15, Srivastava-Hoffert discloses wherein said authoritative metadata is obtained from at least one of a multimedia file, a streaming media file, a uniform resource indicator (URI), a database, a media file header, a media file footer, a metatag, and a transport stream. (Srivastava-Column 3 Lines 1-10 Column 4 Lines 30-60)

With respect to Claim 16, Srivastava-Hoffert discloses wherein said metadata comprise elements related to at least one of content of the media, intellectual property

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rights associated with the media, and instantiation of the media. (Srivastava-Column 2 Lines 20-40, 'copyright notices')

With respect to Claim 17, Srivastava-Hoffert discloses wherein said media is at least one of streaming media and multimedia files formatted in at least one of a plurality of formats. (Srivastava-Column 1 Lines 40-60, Column 2 Lines 25-40 Column 4 Lines 30-60)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Srivastava et al. (US Patent 654922) in view of Hoffert (US Patent 6374260) in view of Chu et al. (US Patent 6943720).

Srivastava-Hoffert substantially disclosed the claimed invention as described in the rejection for Claim 1.

Furthermore with respect to Claims 4 and 12 Srivastava-Hoffert discloses receiving said metadata and corresponding media files, wherein said corresponding media files are formatted in at least one of a plurality of formats; providing media files formatted in the same format and associated metadata to a corresponding format specific metadata extractor; (Srivastava-Figure 1, Column 2 Lines 40-65, Column 4 Lines 30-60, Column 5 Lines 1-5, Column 6 Lines 15-20)

However, with respect to Claims 4,12 Srivastava-Hoffert does not disclose determining if a media file is unavailable or corrupt; and if said media file is unavailable or corrupt, performing said step of comparing at a predetermined time in the future.

Chu discloses (re. Claim 4, 12) a method for a metadata synchronizer wherein, at specified intervals, an object is monitored to identify changes to metadata of that object. The method may be used to check if the URL describing the location of a media file is still working after a certain period of time. (Chu-Abstract, Column 7 Lines 35-65)

Srivastava,Hoffert and Chu are analogous art because they present concepts and practices regarding extraction, update and management of metadata associated with media files. It is respectfully suggested that at the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate a monitoring schedule for checking the validity of metadata related to a media file as taught by Chu

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into the method and system described by Srivastava-Hoffert. The suggested motivation would have been, as Chu suggests, to allow for situations wherein the system enables users to add or modify metadata for objects in a database. Additionally, some systems may store the metadata for the objects in multiple locations. If the metadata stored at one location changes, the metadata stored at other locations is no longer in synch. Monitoring the media files for validity results in timely updates to the metadata for the media files before the users can detect the inconsistencies in the system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREG BENGZON whose telephone number is

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(571)272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. B./
Examiner, Art Unit 2444

/William C. Vaughn, Jr./
Supervisory Patent Examiner, Art Unit 2444

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